

REMARKS

This amendment responds to the office action mailed January 16, 2003. In the office action the Examiner:

- rejected claims 1-21 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,754,938 to Herz *et al.* (Hereinafter "Herz").

After entry of this amendment, the pending claims are: claims 1-21. Applicants respectfully traverse the rejection of claims 1-21. Applicants note that Herz issued on May 18, 1998, which is less than one year before the filing date of the present application (i.e. April 7, 1999). Therefore, 35 U.S.C. 102(b) is inapplicable here. We assume the Examiner meant to reject these claims under 35 U.S.C. 102(a) or 102(e), and we will respond accordingly.

The Legal Standard. The standard governing anticipation under 35 U.S.C. § 102 is one of strict identity (*see* M.P.E.P. § 2131). The Court of Appeals for the Federal Circuit has held that anticipation can be established only by a single reference that teaches each and every element of the claimed invention; anticipation is not shown even if the differences between the claims and the cited reference are argued to be "insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art (*Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 USPQ 1264 (Fed. Cir. 1984)). Furthermore, in *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985) the court pointed out that the assertion of invalidity for lack of novelty is erroneous if a reference teaches "substantially the same thing." A cited reference must meet each claim limitation in order to constitute anticipation.

The Claimed Invention. The present invention relates to extracting data of interest from the world wide web. The descriptions of data of interest can include computer programs comprising a sequence of instructions and extractor patterns. (Specification, page 3, lines 13-15). In other words, descriptions of data of interest are computer programs for extracting data from a web site. One aspect of the invention focuses on providing tools, for example GUIs, to allow programmers and non-programmers alike (*e.g.*, users) to develop descriptions of data of interest and extractor patterns in order to extract and provide data from various sources. In one embodiment, the user can use the extracted data to comparison shop

across web sites. The user defines the categories of goods to be compared and the extraction parameters for gathering data of interest on goods from various web sites. Referring to Figure 3, for example, the user specifies the extraction parameters, *e.g.* inputs, for a category of data of interest for a given web site. The exact inputs will vary based on the category. The extraction parameters are the types of attributes or criteria that a user of the computer 100 can use to control the extraction of data of interest. (Specification, page 13, lines 2-5; Figures 1-3). For example, in the books category of a comparison shopping service, the listed extraction parameters might include the title and author, which the user/author may then choose from as part of their desired data of interest program. In this way, the user is defining and customizing the categories and parameters upon which its data of interest program is going to extract information for comparison. This all relies on receiving a selection of at least one extraction parameter in the list of extraction parameters as recited in claim 1, wherein the user provides the selection of the extraction parameters associated with the chosen product category.

Herz does not disclose receiving a selection of at least one extraction parameter in the list of extraction parameters. In fact, Herz does not disclose a list of extraction parameters. Rather, Herz teaches a method of organizing a large number of objects using a pre-set hierarchical clustering tree and then using menus organized to present the user with the most interesting objects in the forefront.

Herz discloses user interest profiles. However, these are based on a historical record of what types of objects a given user has previously shown interest in, as opposed to extraction parameters selected by a user. Herz does allow the user to enter search queries that may impact their historical user interest profile, but the entry of search queries is not equivalent to the act of receiving a selection of at least one extraction parameter in a list of extraction parameters.

Herz does not allow a user to define how the menus or data are presented. Specifically, the user does not choose categories or extraction parameters that define programs to extract data from various web sites and to then present the data in a customized manner. Herz looks at a user's past interest in objects and then uses its pre-set hierarchical tree to match a given branch or leaf of that tree to the user's interest so that the most interesting set of objects for that user may be presented to them. Herz does not allow the user to define what parameters will be used to define its interest nor does Herz allow a user to

choose from a list of parameters for the extraction of data. Herz's use of general search queries for a user to express interest in seeing objects of a certain type is not the same as "receiving a selection of at least one extraction parameter in the list of extraction parameters." As such, Herz does not teach each and every element of claim 1, as required by M.P.E.P. §2131.

Independent claim 18 contains equivalent language to that discussed above for claim 1. Specifically, independent claim 18 recites in pertinent: "means for receiving a selection of at least one extraction parameter in the list of extraction parameters." The same arguments detailed above apply equally to claim 18. Additionally, claims 2-17 and 19-20 depend from claims 1 or 18. Therefore, these claims are not anticipated by Herz for at least the same reasons that claims 1 and 18 are not anticipated by Herz.

As to claim 21, Herz does not teach each and every element of the claim. Specifically, Herz does not teach at least the following pertinent parts of claim 21:

"a set of instructions for receiving a selection of an instruction from a predefined set of instructions for inclusion of the instruction in the description of data of interest;" and
"a set of instructions for testing the instruction using the extractor pattern and the contents of a buffer."

First, Herz does not teach or suggest the claimed set of instructions for receiving a selection of an instruction from a predefined set of instructions. As shown at pages 16-17 of the specification, for example, a predefined set of program instructions are offered for a user to choose from in developing the description of data of interest (*e.g.*, computer program) that will be used to extract data from various web sites for presentation to the user. Respectfully, Herz does not teach or suggest this computer program development using a "pre-defined set of instructions" anywhere in its disclosure, nor does it teach receiving from a user a selection of one of those pre-defined sets of instructions. Overall, Herz does not teach the development of a user-defined program for extracting data from web sites.

Second, Herz does not teach or suggest testing the selected instruction using the extractor program and the contents of a buffer. As detailed above, Herz does not teach user-chosen instructions for developing a program to extract information from websites, and so there is no reason for Herz to teach testing such instructions. Herz does not teach testing

anywhere in its disclosure, and specifically not testing using an extractor pattern and the contents of a buffer.

Furthermore, as the Examiner states that such instructions for testing are "inherent" in Herz, Applicants respectfully request that the Examiner provide rationale and evidence tending to show the asserted inherency as required by M.P.E.P. §2112. As cited in M.P.E.P. §2112 (at p. 2100-52):

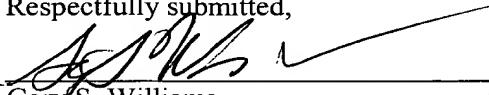
"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990) (emphasis in original).

The claimed set of instructions for testing the instruction using the extractor pattern and the contents of a buffer do not necessarily flow from the cited portions of Herz (i.e. column 70, lines 11-61 or column 14, lines 48-64), neither of which mention testing, extractor patterns or buffers. Furthermore, Applicants did not find references to these term elements anywhere in Herz.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 493-4935, if a telephone call could help resolve any remaining items.

Date: April 16, 2003

Respectfully submitted,


Gary S. Williams

31,066
(Reg. No.)

PENNIE & EDMONDS LLP
3300 Hillview Avenue
Palo Alto, California 94304
(650) 493-4935